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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,574	01/25/2001	Masafumi Aikawa	018656-197	3581

21839 7590 01/30/2004

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EXAMINER

ZHOU, TING

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

3

Office Action Summary

Application No.

09/768,574

Applicant(s)

AIKAWA, MASAFUMI

Examiner

Ting Zhou

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

1. The amendment filed on 17 December 2003 have been received and entered. Claims 1-21 as amended are pending in the application.
2. The previous rejections have been overcome by the amendments and arguments filed on 17 December 2003 and have subsequently been withdrawn. However, a new rejection on the merits follows herewith.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-6, 8-11, 13-15, 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ono et al. U.S. Patent 6,295,136.

Referring to claims 1 and 13, Ono et al. teach, in column 1, lines 65-67 and column 2, lines 1-10 lines an image processing apparatus (printer) comprising a plurality of entry screens, first display means for selectively displaying an entry screen from the plurality of entry screens (choosing one tab section from a plurality of tabs shown in Figure 5), setting means for setting an operation condition on the displayed entry screen (setting values such as paper size, orientation, number of copies, etc.), a list screen on which all the set operation conditions are collectively displayed (the list labeled "Current Settings" in Figure 5 and the data display area shown by reference character "F6" in Figures 7 and 9 displays the summary of the operation conditions set in that particular tab section) and second display means for displaying the entry screen displayed by the first display means and the list screen at the same time (the "Current Settings" section and the display area "F6" are shown on the same display as the entry tab screens that allowed the users to set the operation conditions) (column 5, lines 11-28).

Referring to claims 2 and 14, Ono et al. teach an image processing apparatus comprising a display, first control means for selectively displaying an entry screen from a plurality of entry screens on the display, setting means for setting an operation condition on the displayed entry screen and second control means for displaying the entry screen displayed by the first display means and a list screen on which all the set operation conditions are collectively displayed at the

same time, as recited in column 1, lines 65-67, column 2, lines 1-10 and column 5, lines 11-28.

This can further be seen in Figures 5, 7 and 9.

Referring to claims 3, 4 and 5, Ono et al. teach a setting method and computer program product (column 6, lines 39-43) comprising the steps of a first step in which one of a plurality of entry screens is displayed, a second step in which an operation condition is set on the displayed entry screen, a third step in which a plurality of operation conditions is set by repeating the first step and the second step and a fourth step in which a list of all the set operation conditions and the entry screen are displayed at the same time, as recited in column 5, lines 11-47 and further shown in Figures 5, 7 and 9.

Referring to claims 6 and 15, Ono et al. teach an operation condition setter for setting values for a plurality of items specifying operation conditions of an image processing apparatus (column 5, lines 11-13). Specifically, Ono et al. teach selection means for selecting one group from among a plurality of groups into which the items are classified (the tab section that the item belongs to, for example, "Information", "Details", "Common", "Main", "Paper" and "Utility"), first generation means for generating an entry screen for entering data for an item belonging to the selected group, first display control means for displaying the entry screen on a display, setting means for registering the data entered for the item on the entry screen as a set value of the item, second generation means for generating a list of setting results of the operation conditions based on the set values of all the items and second display control means for displaying the list on the display (displaying the list labeled "Current Settings" in Figure 5 and the data display area shown by reference character "F6" in Figures 7 and 9, which show the summary of the operation

conditions set in that particular tab section), as recited in column 1, lines 65-67, column 2, lines 1-10 and column 5, lines 11-47.

Referring to claims 8 and 17, Ono et al. teach the second generation means for generating the list of setting results of the operation conditions by use of symbols including letters, numbers and icons, as shown in Figure 5.

Referring to claims 9 and 18, Ono et al. teach the second generation means generating the list so as to include settable values, as can be seen from Figures 5 and 6.

Referring to claims 10 and 19, Ono et al. teach identification means for identifying, among the setting results shown in the list, a setting result decided based on the set value of an item on the displayed entry screen, wherein the second display control means displays the list so that the identified setting result is distinguished from the other setting results (the setting results shown under "Current Settings" are decided based on the set values from "More Settings" and are thus shown in its own boxed section so as to distinguish it from the other setting results), as shown in Figures 5 and 6.

Referring to claims 11 and 20, Ono et al. teach selection means for selecting one of the setting results shown in the list and switching means (switching between tabs as recited in column 14, lines 31-33) for switching the entry screen to an entry screen including an item deciding the selected setting result, wherein the first display control means displays the entry screen including an item deciding the selected setting result, as recited in column 11, lines 52-57 and 61-65. This can further be seen in Figures 5 and 6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 12, 16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono et al. U.S. Patent 6,295,136, as applied to claims 6 and 15 above, and further in view of Kimoto et al. U.S. Patent 5,390,005.

Referring to claims 7 and 16, while Ono et al. all of the limitations as applied to the claims above, they fail to teach detection means for detecting a combination of set values at which the image processing apparatus can operate and inhibition means for inhibiting a combination of set values at which the image processing apparatus cannot operate. Nakazato et al. teach a processing apparatus similar to that of Ono et al. In addition, Nakazato et al. disclose detection means for detecting a combination of set values at which the image processing apparatus can operate and inhibition means for inhibiting a combination of set values at which the image processing apparatus cannot operate (detection of differently punched sheets stored in the tray and prohibition means that prohibits the stapling operation on these conditions), as recited in column 1, lines 55-59 and column 5, lines 27-37. It would have been obvious to one of ordinary skill in the art, having the teachings of Ono et al. and Nakazato et al. before him at the time the invention was made, to modify the operation condition setter taught by Ono et al. to

include the detection and prohibition means of Nakazato et al. It would have been obvious for one to make such a combination in order to prevent the users from setting invalid operation condition values for operations that cannot be performed. By detecting and prohibiting these invalid values from being set, the image processing apparatus reduces its chance of attempting to do an erroneous task and breaking down.

Referring to claims 12 and 21, Ono et al. teach all of the limitations as applied to the claims above. They also teach the operation condition of the image processing apparatus is at least one of an operation condition associated with a print function (column 1, lines 8-11). However, Ono et al. fail to teach an operation condition associated with a post processing function performed after printing. Nakazato et al. teach an operation condition associated with post processing functions performed after printing (such as stapling and punching), as recited in column 1, lines 60-67. It would have been obvious to one of ordinary skill in the art, having the teachings of Ono et al. and Nakazato et al. before him at the time the invention was made, to modify the operation condition setter taught by Ono et al. to include the post processing functions of Nakazato et al. It would have been advantageous for one to utilize such a combination in order to provide users with more processing functions, allowing users to better organize the image they produce, by sorting and stapling the printed documents, for example.

5. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach image processing apparatuses for setting operation conditions.

Response to Arguments

6. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

As shown above, the newly applied Ono et al. reference teaches “an image processing apparatus wherein an entry screen is displayed at the same time as a list screen on which all set operation conditions are displayed” by showing a list screen on which all the set operation conditions are collectively displayed (the list labeled “Current Settings” in Figure 5 and the data display area shown by reference character “F6” in Figures 7 and 9 displays the summary of the operation conditions set in that particular tab section) and second display means for displaying the entry screen displayed by the first display means and the list screen at the same time (the “Current Settings” section and the display area “F6” are shown on the same display as the entry tab screens that allowed the users to set the operation conditions), as recited in column 5, lines 11-28.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (703) 305-0328. The examiner can normally be reached on Monday - Friday 7:00am - 4:30pm.

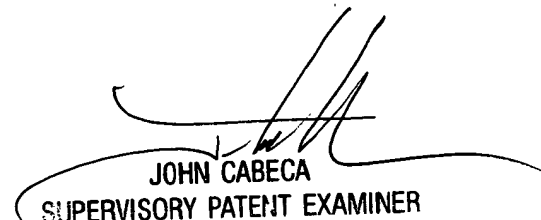
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

January 22, 2004



JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100